

### **REMARKS**

Applicant thanks the Examiner for total consideration given the present application. Claims 1-6 were pending prior to the Office Action. Claims 7-9 have been added through this Reply. Therefore, claims 1-9 are currently pending. Claims 1, 3, and 5 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks and amendments.

#### **Amendment**

Amendment to the specification is editorial in nature. It is respectfully submitted that no new matter has been entered by this amendment.

Amendment to claim 3 is also editorial in nature. Specifically, claim 3 has been amended by replacing "mean" with -- means --. Applicant respectfully submits that the amendment made to claim 3 does not add any new matter to the application and it is not narrowing, and is not made for a reason relating to patentability. Accordingly, it is submitted that the amendment does not give rise to estoppel and, in future analysis, claim 3 is entitled to its full range of equivalents.

#### **Claim Rejections - 35 U.S.C. § 102**

Claims 1-2 and 5-6 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Minamino et al. (US Patent 7,038,993), hereinafter Minamino. This rejection is respectfully traversed.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. See M.P.E.P. 2131; M.P.E.P. 706.02. Thus, if the cited reference

fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In regard to independent claim 1, Minamino fails to teach or suggest each and every claimed element. More specifically, claim 1 recites, *inter alia*, **“a file position identifying means for acquiring a logical block number indicating a position of a file from the logical block number acquired by said file entry acquiring means and from the logical sector number acquired by said partition acquiring means, and for identifying a logical sector number indicating the position of the file from the logical block number acquired thereby and from the logical sector number acquired by said partition acquiring means.”** *Emphasis added.*

Minamino discloses a conventional optical disc medium which includes a plurality of sector groups, each being made up of multiple sectors that are contiguous with each other in a circumferential direction on a track. Minamino further discloses that in at least some of the sector groups, the location information thereof is divided into multiple pieces of information and distributed to associated ones of the sectors on the same track (Fig. 1(a) and 1(b); col. 2, lines 18-24). Specifically, Minamino is concerned with decreasing the size of “overhead area” (e.g. address area) and increasing the storage capacity of the optical disc (col. 2, lines 4-14). In order to minimize such size of “overhead area”, Minamino’s optical disc medium provides a track that is made up of a plurality of contiguous sector groups (105) consisting of 32 sectors (104) that are contiguous with each other on the track, wherein each of the sectors (104) includes a header filed (102) located at top thereof and a recording field (103) that follows the header filed (102) (col. 5,

lines 23-28). In an exemplary embodiment, Minamino discloses that to access a target sector in a sector group, a given sector group is identified first by detecting the location information of the sector group in order to access the sector group including the target sector and then by counting each sector of that sector group until the target sector is accessed (col. 7, lines 49-55). An identification mark, representing the location information of each sector group, must be arranged dispersively and periodically between the recording fields of adjacent sectors in order to reduce the overhead size (col. 7, line 65 – col. 8, line 4).

Applicant respectfully submits that the identification mark of Minamino, representing the location information of each sector group, cannot be properly interpreted as the **“file position identifying means”** claimed by the Applicant. In addition, Minamino merely teaches a step of logical processing which is known for recording information on an optical disk. Such logical processing is distinguished from the claimed invention in that Minamino performs logical processing to correct an error occurring during a read or write operation by using a predetermined number of sector as one block (col. 10, lines 31-49). Whereas, claim 1 requires that a **logical block number is acquired by the file position identifying means to indicate a position of a file from the logical block number acquired by the file entry acquiring means and from the logical sector number acquired by the partition acquiring means.** Furthermore, claim 1 is distinguished over Minamino in that it requires the file position identifying means for identifying a logical sector number indicating the position of the file **from the logical block number** acquired thereby and from the logical sector number acquired by the partition acquiring means.

As in claim 1, independent claim 5 similarly recites, *inter alia*, “**a file position identifying means for identifying a logical sector number indicating a position of a file from a logical block number determined thereby by searching for a predetermined file identifier, the logical block number indicating a location from which data is to be reproduced, and from the logical sector number indicating the starting location of the partition, which is calculated by said partition acquiring means.**” Applicant respectfully submit that this claim element is not taught by Minamino at least for the reasons set forth above with respect to claim 1.

Therefore, for at least these reasons, independent claims 1 and 5 are distinguishable from Minamino. Claim 2 depends from claim 1 and claim 6 depends from claim 5. Therefore, for at least the reasons stated with respect to claims 1 and 5, claims 2 and 6 are also distinguishable from Minamino. Furthermore, new dependent claims 7 and 9 recite, *inter alia*, “**wherein said file position identifying means identifies the logical sector number indicating the position of the file stored in across a plurality of sectors.**” Applicant respectfully submits that Minamino fails to disclose this claim feature.

Accordingly, Applicant respectfully requests that the rejection of claims 1-2 and 5-6, based on Minamino, be withdrawn.

**Claim Rejections - 35 U.S.C. § 103**

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Minamino et al. (US Patent 7,038,993), hereinafter Minamino, in view of Ando et al. (US Patent 6,594,725), hereinafter Ando. This rejection is respectfully traversed.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. See M.P.E.P. 2142. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See M.P.E.P. 2142; M.P.E.P. 706.02(j). Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

As in claim 1, independent claim 3 similarly recites, *inter alia*, **“a file position identifying means for acquiring a logical block number indicating a position of a file from the file entry that exists at the logical block number acquired by said file entry acquiring means, and for identifying a logical sector number indicating the position of the file from the logical block number acquired thereby and from the logical sector number acquired by said partition acquiring means and indicating the starting location of the partition.”** As demonstrated above, Minamino fails to teach this claim element. Ando has not been, and indeed cannot be, relied upon to correct at least this deficiency of Minamino.

Another requirement to establish *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited reference(s) to modify the reference(s) as proposed in the Office Action. See M.P.E.P. 2143.01. The cited reference must be considered in its entirety. See M.P.E.P. 2141.02. If the proposed modification renders the cited reference unsatisfactory for its intended purpose, then by definition, there is no suggestion or motivation to make the

proposed modification. See M.P.E.P. 2143.01. Thus, if the proposed modification renders the cited reference unsatisfactory for its intended purpose, the rejection must also fail.

It is respectfully submitted that the two cited prior art references taken either alone or in combination do not recognize the problem solved by the Applicant's claimed invention or include all the features of independent claim 3 as demonstrated above. More specifically, the Applicant's claimed invention solves the unrecognized problem of a data reproducing apparatus that can identify the position of a file recorded on a disk even if a data loss occurs in the management information about the file without changing the standard to which the file system of the disk conforms (please see page 2, lines 4-9 of the instant application). In order to solve such problem, the claimed invention requires a partition acquiring means, a root directory acquisition means, a file entry acquisition means and a file position identifying means as illustrated in Figs. 2, 18, and 21. Moreover, it is respectfully submitted that only a person skilled in the art who had access to the present application would be motivated to combine the teachings of the four cited prior art references in order to solve the unrecognized problem disclosed in Applicant's specification. In other words, the only motivation to combine the four cited references in the way suggested in the Office Action is gleaned from the hindsight provided by Applicant's specification.

The Applicants respectfully submit that the Office Action is based upon a selective combination of features found in the two references, and that such selective combining is impermissible. As stated in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985), "When prior art references require selective combination by the court to render obvious a

subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." It is respectfully submitted that the Office Action cites the Minamino patent, and then utilizes the present application as a road map to selectively replace various features of the Minamino reference.

The Office Action admits that Minamino does not disclose a root directory acquisition means, but alleges that it would be obvious to combine Minamino with Ando to improve management of file identification in order to make it easier to identify and manage different types of data. It is respectfully submitted that the rejection of claim 3 is a blatant string of substitutions gleaned from and motivated by the Applicant's own patent application. The Office Action has not shown that the prior art provides the teaching or suggestion to make the claimed combination and the reasonable expectation of success. The suggestion to make the claimed combination and the reasonable expectation of success cannot be based on Applicant's disclosure.

Accordingly, it is respectfully submitted that claim 3 is patentable over the impermissible combination of references cited against claim 3. Claim 4 is patentable at least by virtue of its dependency on claim 3.

### **New Claims**

New dependent claim 7 depends from claim 1, new dependent claim 8 depends from claim 3, new dependent claim 9 depends from claim 5. Therefore, for at least the reasons stated above with respect to claims 1, 3, and 5, claims 7-9 are also distinguishable from Minamino. Furthermore, new dependent claims 7-9 recite, *inter alia*, "**wherein said file position**

**identifying means identifies the logical sector number indicating the position of the file stored in across a plurality of sectors.”** Applicant respectfully submits that Minamino fails to disclose this above identified claim feature.

**Conclusion**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Ali M. Imam, Reg. No. 58,755 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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